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The

UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Cohn, et al.
Filed : March 13, 2001
Serial No. : 09/804,745
For : Novel Polymeric Compositions
Group Art Unit : 1617
Examiner : E. Webman

SIR:

Further Election of Species

In response to the Examiner's office action of June 6, 2005, in the above-referenced patent application, Applicant provisionally elects with traverse to prosecute the invention set forth in Group A, namely a crosslinked polymer comprising AB diblocks and multiblocks which are endcapped at both ends. These claims are primarily directed to polymeric composition species comprised of AB diblocks or multiblocks, which are end-capped with an alkyl group (preferably a methyl group) and which are crosslinked. The elected monomer of the A block (ester unit) is obtained from lactide (claim 6). A bioactive agent is not present. Claims 1-3, 6-7 and 15-22 are readable on the elected species.

Notwithstanding Applicants election, Applicants respectfully traverse the Examiner's requirement for restriction. Applicants respectfully submits that prosecution of the originally filed claims should not be restricted to the elected species. It is respectfully submitted that after the prosecution of the application which issued as U.S. No. 6,211,249, the pending claims are directed to compositions which are sufficiently narrow to allow examination of all the claims within this application in an efficient manner.

According to M.P.E.P. §803, restriction by the Examiner of patentably distinct inventions is proper if the claimed inventions are independent and a serious burden would be placed on the Examiner if restriction was not required. Applicant respectfully submits that the presentation of the originally filed claims in group I would not place such a serious burden on the Examiner as to require restriction. All of the originally filed claims are related, though patentably distinct compositions which are primarily used for reducing and/or eliminating adhesion.

Although the claimed compositions are generally patentably distinct from each other,

Applicants respectfully submit that any search the Examiner would need to conduct in examining the instant application set forth in claims 1-3, 6-7 and 15-22 would not be unduly burdensome. Moreover, the examination of these claims would not place such a serious burden on the Examiner as to require restriction.

Applicants understand the general policy considerations for the Patent Office's requirement for restriction in certain instances. In this instance, however, those considerations do not weigh in favor of restricting the inventions here. In determining the appropriateness of restriction, one must also consider the countervailing consideration that, in each instance, Applicant wishes the Patent Office to examine his or her application with a certain degree of "judicial efficiency" and wishes to have patent claims issue which reflect the breadth of his or her invention. The balance that is to be weighed should be tipped in this instance by the fact that the claimed compositions set forth in claims 1-3, 6-7 and 15-22 are sufficiently narrow to weigh on the side of examining all the claims indicated above, especially in light of the earlier prosecution of the parent application.

Applicants respectfully submit that the originally filed claims are sufficiently narrow to allow the Examiner to determine patentability without being subjected to the serious burden referred to in M.P.E.P. §803. Consequently, Applicant respectfully requests that the Examiner examine all of the claims set forth above, namely claims 1-3, 6-7 and 15-22. No fee is due for the presentation of this paper. If the Examiner decides that a fee is due, please debit deposit account 04-0838,

Respectfully submitted,

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By: 

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Dated: July 5, 2005

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on July 5, 2006.


Henry D. Coleman (Reg. No. 32,559)